

## **REMARKS**

In view of the above amendments and the following remarks reconsideration and further examination are respectfully requested.

### **I. Amendments to the Claims**

Claims 15-21 have been amended to clarify features of the invention recited therein and to further distinguish the present invention from the references relied upon in the rejections discussed below. In this regard, Applicants note that the amendments of the pending claims are supported by, for example, the third embodiment and the fifth embodiment of the specification.

### **II. Claim Rejections under 35 U.S.C. § 101**

Claims 15-21 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. By the present amendment, Applicants have amended claims 15-21 to recite physical hardware (e.g., a processor, a memory, etc.). Specifically, it is noted that the previously claimed “judging unit” and “reading unit” have been replaced with the term “processor,” and the previously claimed “recording medium” has been replaced with the term “memory”. The amendments are supported, for example, at page 9, lines 17-22 of the specification. Thus, Applicants respectfully request that the rejection be withdrawn.

### **III. Claim Rejections under 35 U.S.C. § 112**

Claims 15-21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which Applicants regard

as the invention. By the present amendment, Applicants have amended claims 15-21 to claim “a system”.

Applicants also have amended claim 15 to clarify the scope of the invention, for example claim 15 now describes limitations related to “when the processor judges that the disc region code does not match the apparatus region code,” as requested by the Examiner. The amendments are supported, for example, at page 14, line 9- page 22, line 13 of the specification and Figs. 5 and 6.

Applicants further have amended claim 15 to recite “replaces the predetermined part of the content ... with the substitute content ..., in order to create a predetermined package” instead of “a predetermined package created by *replacing* the predetermined part of the content ...with the substitute content”.

Further, regarding claims 18 and 19, the Applicants note that “the server apparatus” is not identified as a part of the claimed invention, but is rather identified as an apparatus with which the claimed system communicates.

Thus, in view of the above, Applicants respectfully request that these rejections be withdrawn.

#### **IV. Claim Rejections under 35 U.S.C. § 103**

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (U.S. 6,141,483) in view of Yoshii et al. (U.S. 2003/0090711) and Candelore et al. (U.S. 2003/017837). Claims 16-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada/Yoshii/Candelore in view of Official Notice. These rejections are believed clearly

inapplicable to amended claims 15-21 for the following reasons.

Independent claim 15 recites a system including an optical disc having a disc region code assigned thereto and having content and a content identifier identifying the content recorded thereon and including a playback apparatus (having an apparatus region code assigned thereto) that plays back the optical disc. The playback apparatus including, in part, (1) a memory that stores predetermined additional data corresponding to the optical disc, wherein the predetermined additional data includes a substitute playback order of the content recorded on the optical disc and a substitute content, such that a predetermined part of the content recorded on the optical disc is capable of being replaced by the substitute content, and the memory is distinct from the optical disc. Further, claim 15 recites (2) a processor that, when the processor itself judges that the disc region code does not match the apparatus region code, judges whether a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, (3) wherein, when the processor judges that the combination of the content identifier read by the processor and the apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content, the processor replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds corresponding to the optical disc, in order to create a predetermined package, based on the substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (4) a playback unit that play backs the created predetermined package.

The Yamada, Yoshii and Candelore references, or any combination thereof, fail to

disclose or suggest the above-mentioned distinguishing features (1)-(4) as recited in independent claim 15.

Rather, Yamada teaches various reproducing means for reproducing data only from a recording medium when certain conditions are satisfied (see abstract and col. 3, line 50 - col. 4, line 22). Specifically, Yamada teaches that reproduction of the data recorded on the recording medium is performed if (i) a region code of the recording medium matches the apparatus code of the playback apparatus, (ii) a certain amount of time has not expired from the formation of the data on the recording medium, and (iii) a certain condition is satisfied between specific data recorded on the recording medium and specific data set in the playback apparatus (see col. 3, line 50 - col. 4, line 22).

Thus, in view of the above, it is clear that Yamada teaches that reproduction of the data recorded on the recording medium is performed if conditions (i) - (iii) are satisfied, but does not disclose or suggest the playback apparatus for playing back content from an optical disc and including a memory that stores predetermined additional data corresponding to the optical disc, wherein the predetermined additional data includes a substitute playback order of the content recorded on the optical disc and a substitute content, such that a predetermined part of the content recorded on the optical disc is replaced by the substitute content, and the memory is distinct from the optical disc, as required by independent claim 15.

In this regard, the Examiner admitted in the Official Action dated on August 26, 2008 that Yamada fails to disclose (1) a memory that stores predetermined additional data corresponding to the optical disc, wherein the predetermined additional data includes a substitute playback order of the content recorded on the optical disc and a substitute content, such that a

predetermined part of the content recorded on the optical disc is replaced by the substitute content, and the memory is distinct from the optical disc, as required by independent claim 15.

Further, in view of the above, it is apparent that Yamada fails to disclose or suggest (2) a processor that, when the processor itself judges that the disc region code does not match the apparatus region code, judges whether a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, (3) wherein, when the processor judges that the combination of the content identifier read by the processor and the apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content, the processor replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, in order to create a predetermined package, based on the substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (4) a playback unit that plays back the created predetermined package, as recited in independent claim 15.

In particular, Applicants submit that Yamada does not contain any disclosures regarding the condition of when “a combination of the content identifier read by the processor and the apparatus region code” satisfies a predetermined condition defined by an owner of the rights of the content, as recited in claim 15. Instead, Yamada merely teaches the above conditions (i) - (iii).

More specifically, according to claim 15, even if the processor judges that the disc region code does NOT match the apparatus region code, when a combination of the content identifier

read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, the playback unit plays back a created predetermined package. A distribution company that distributes the content has an interest from the content at the region where the play back apparatus is placed. If an owner of the rights of the content does not protect the interest of the distribution company, a relationship between the distribution company and the owner of the rights of the content will be worsened. Thus, according to independent claim 15, when “a combination of the content identifier read by the processor and the apparatus region code” satisfies a predetermined condition defined by an owner of the rights of the content, the playback unit plays back a created predetermined package (see page 4, lines 3-18). In this regard, Yamada does not disclose any of the above-mentioned distinguishing limitations, as recited in claim 15, since Yamada merely teaches the above conditions (i) - (iii).

In setting forth the rejection, the Examiner relies on Yoshii for teaching that which the Examiner admits is lacking in Yamada. Regarding the Yoshii reference, Applicants note that this reference discloses a distribution system for digital image content. The distribution system distributes the digital content and secondary data, reproduces the digital content and the secondary data, and superimposes the two reproduced data. The secondary data is prepared using a markup language such that a reproduction start point and a reproduction end point correspond to an image frame-specific code for specifying an image of the digital data.

However, Yoshii fails to disclose (1) a memory that stores predetermined additional data corresponding to the optical disc, wherein the predetermined additional data includes a substitute playback order of the content recorded on the optical disc and a substitute content, such that a predetermined part of the content recorded on the optical disc is replaced by the substitute

content, and the memory is distinct from the optical disc, as required by independent claim 15.

Rather, Yoshii merely teaches that the distribution system superimposes the distributed digital content and the distributed secondary data, as shown in Fig. 2 of Yoshi. Thus, Yoshii does not contain any disclosures regarding a memory that stores predetermined additional data including a substitute playback order of the content recorded on the optical disc and a substitute content, such that a predetermined part of the content recorded on the optical disc is replaced by the substitute content.

In this regard, the Examiner admitted in the Official Action dated on August 26, 2008 that Yamada fails to disclose a memory that stores predetermined additional data corresponding to the optical disc, “the predetermined additional data including a substitute playback order of the content recorded on the optical disc and a substitute content, a predetermined part of the content recorded on the optical disc being replaced by the substitute content”, as required by independent claim 15.

Yoshii also fails to disclose (2) a processor that, when the processor itself judges that the disc region code does not match the apparatus region code, judges whether a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, (3) wherein, when the processor judges that the combination of the content identifier read by the processor and the apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content, the processor replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, in order to create a predetermined package, based on the

substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (4) a playback unit that plays back the created predetermined package, as recited in independent claim 15.

Rather, Yoshii merely teaches that the distribution system superimposes the distributed digital content and the distributed secondary data, as shown in Fig. 2 of Yoshii. Thus, Yoshii does not contain any disclosures regarding (3) the processor that replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, in order to create a predetermined package, based on the substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (4) the playback unit that play backs the created predetermined package, as shown in, for example, Fig. 22, of the present application.

Further, Applicants submits that Yoshii does not contain any disclosures regarding the condition of when “a combination of the content identifier read by the processor and the apparatus region code” satisfies a predetermined condition defined by an owner of the rights of the content, as recited in claim 15.

In setting forth the rejection, the Examiner relies on Candelore regarding that which the Examiner admits is lacking in the Yamada and Yoshii. Regarding the Candelore reference, Applicants note that this reference discloses a method and apparatus for content substitution. In Candelore, the content having a first program identifier is placed into a data stream, the content having a second program identifier is mapped to the first program identifier, and the mapped content is placed to the data stream. The content substitution process can be used to replace



advertisements, to provide multiple plots, multiple endings, multiple views as well as other applications (see Fig.6).

However, the Applicants submit that Candelore fails to disclose or suggest at least (2) a processor that, when the processor itself judges that the disc region code does not match the apparatus region code, judges whether a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, (3) wherein, when the processor judges that the combination of the content identifier read by the processor and the apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content, the processor replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, in order to create a predetermined package, based on the substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (4) a playback unit that play backs the created predetermined package, as recited in independent claim 15.

Rather, Candelore merely teaches that if a prescribed substitution criterion is met (see Fig. 1, 116), the content substitution is carried out (see Fig. 1, 124), and if the prescribed substitution criterion is not met (see Fig. 1, 116), the content substitution is not carried out (see Fig. 1, 120, and paragraphs [0027] and [0028]). In Candelore, the prescribed substitution criterion is the presence or absence of a national advertisement, watermark or logo that a local content distributor wishes to replace with a local or regional advertisement (paragraph [0027]). Therefore, Candelore does not contain any disclosures regarding a content substitution process

that, if the prescribed substitution criterion is NOT met, carries out some content substitution.

Further, Candelore fails to disclose or even suggest the condition of when “a combination of the content identifier read by the processor and the apparatus region code” satisfies a predetermined condition defined by an owner of the rights of the content, as required by claim 15. Instead, Candelore merely teaches, as the prescribed substitution criterion, that the presence of a national advertisement, watermark or logo can be replaced with a local or regional advertisement, if a local content distributor wishes (see paragraph [0027]).

On the other hand, independent claim 15 recites the condition of when “a combination of the content identifier read by the processor and the apparatus region code” satisfies a predetermined condition defined by an owner of the rights of the content. According to independent claim 15, even if the processor judges that the disc region code does NOT match the apparatus region code, when a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, the playback unit plays back a created predetermined package. A distribution company that distributes the content has an interest from the content at the region where the playback apparatus is placed. If an owner of the rights of the content does not protect the interest of the distribution company, a relationship between the distribution company and the owner of the rights of the content will be worsened. Thus, according to independent claim 15, when “a combination of the content identifier read by the processor and the apparatus region code” satisfies a predetermined condition defined by an owner of the rights of the content, the playback unit plays back a created predetermined package (see page 4, lines 3-18). In this regard, Candelore does not disclose any of the above-mentioned distinguishing limitations required by

claim 15, since Candelore merely teaches, as the prescribed substitution criterion, that the presence of a national advertisement, watermark or logo can be replaced with a local or regional advertisement, if the local content distributed wishes (see paragraph [0027]).

Thus, the independent claim 15 is clearly distinguished over Candelore.

Therefore, Applicants submit that even if one attempted to combine the teaching of Yamada with Yoshii and Candelore in the matter suggested by the Examiner, one would fail to arrive at the presently claimed invention, as such a combination would lack, at least, (2) a processor that, when the processor itself judges that the disc region code does not match the apparatus region code, judges whether a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, (3) wherein, when the processor judges that the combination of the content identifier read by the processor and the apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content, the processor replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, in order to create a predetermined package, based on the substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (4) a playback unit that play backs the created predetermined package, as recited in independent claim 15.

Accordingly, because of the above-mentioned distinctions it is believed clear that claim 15 and claims 16-21 which depend therefrom would not have been obvious or result from any combination of Yamada, Yoshii, Candelore and Official Notice. Furthermore, there is no

disclosure or suggestion in Yamada, Yoshii and/or Candelore or elsewhere in the prior art of record which would have caused a person of ordinary skill in the art to modify Yamada, Yoshii and/or Candelore to obtain the invention of independent claim 15. Accordingly, it is respectfully submitted that independent claim 15 and claims 16-21 which depend therefrom are clearly allowable over the prior art of record.

## **V. Conclusion**

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance and an early notification thereof is earnestly requested. The Examiner is invited to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,

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